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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT PAPER NUMBER

2166

DATE MAILED: 11/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/364,803

Applicant(s)

BAUER ET AL.

Examiner

Christopher L Gilligan

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

Response to Amendment

1. In the amendment filed 9/7/01 in paper number 6, the following has occurred:
Claims 1, 5, 13, 17, 25-27, 29, 31-33, and 35 have been amended. Claims 37-72 have been added. Now, claims 1-72 are presented for examination.
2. Applicant's arguments filed 9/7/01 in paper number 6 have been fully considered but they are not deemed to be persuasive.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Luchs et al., U.S. Patent No. 4,831,526.
5. As per claim 1, Luchs et al. teach an on-line insurance policy service system for real-time automated selective adjustment by a policyholder of policy parameters for a policy and system computation and communication of consequent costs, comprising: an information module for identifying a policyholder to the system and for verifying to the policyholder a present policy parameter (see column 3, lines 44-49); and, a policy adjustment module for selectively communicating a parameter change and for generating in real-time a cost adjustment attributable to the parameter change and directly communicating to the policyholder the cost adjustment (see column 24, lines 17-28, the change must communicated to the policyholder for him/her to approve it).

6. As per claim 2, Luchs et al. teach the system of claim 1 as described above. Luchs et al. further teach including a claims information module (see column 11, lines 63-65).
7. As per claim 3, Luchs et al. teach the system of claim 1 as described above. Pasher further discloses including an electronic funds transfer module (see paragraph 16).
8. As per claim 4, Luchs et al. teach the system of claim 1 as described above. Luchs et al. further teach the parameter change comprises a change in location (see column 8, lines 16-18).
9. As per claim 5, Luchs et al. teach the system of claim 1 as described above. Luchs et al. further teach the parameter change comprises a change in resident address of the policyholder (see figure 11A).
10. As per claim 6, Luchs et al. teach the system of claim 1 as described above. Luchs et al. further teach the parameter change comprises a change in garage location of a vehicle insured under the policy (see column 8, lines 16-18).
11. As per claim 7, Luchs et al. teach the system of claim 1 as described above. Luchs et al. further teach the parameter change comprises a change in item insured by the policy (see column 3, lines 25-29).
12. As per claim 8, Luchs et al. teach the system of claim 7 as described above. Luchs et al. further teach the change in item comprises a change in a person insured under the policy (see column 8, lines 16-18, particularly Addl. Names insured from the table referenced).
13. As per claim 9, Luchs et al. teach the system of claim 7 as described above. Luchs et al. further teach the change in item comprises a change in insurance coverages, deductibles and policy limits under the policy (see column 3, lines 25-29).

14. As per claim 10, Luchs et al. teach the system of claim 7 as described above. Luchs et al. further teach the change in item comprises a vehicle change (see column 25, lines 1-2).

15. As per claim 11, Luchs et al. teach the system of claim 10 as described above. Luchs et al. further teach the vehicle changes comprise adding, replacing, or deleting an insured vehicle under the policy (see column 25, lines 1-13).

16. As per claim 12, Luchs et al. teach the system of claim 1 as described above. Luchs et al. further teach an implementing module for submitting and implementing the parameter change (see column 25, lines 57-60).

17. As per claim 13, Luchs et al. teach an on-line insurance policy service system for real-time automated selective adjustment by a policyholder of policy parameters for an insurance policy, and system computation and communication of changes in coverage under the policy, comprising: an information module for identifying a policyholder to the system and for verifying to the policyholder a present policy parameter of a policy held by the policyholder (see column 3, lines 44-49); and, a policy adjustment module for selectively communicating a parameter change from the policyholder, for generating in real-time a cost adjustment attributable to the parameter change and for communicating the coverage adjustment directly to the policyholder (see column 24, lines 17-28 the change must communicated to the policyholder for him/her to approve it).

18. As per claim 14, Luchs et al. teach the system of claim 13 as described above. Luchs et al. further teach including a claims information module (see column 11, lines 63-65).

19. As per claim 15, Luchs et al. teach the system of claim 13 as described above. Pasher further discloses including an electronic funds transfer module (see paragraph 16).

20. As per claim 16, Luchs et al. teach the system of claim 13 as described above. Luchs et al. further teach the parameter change comprises a change in location (see column 8, lines 16-18).

21. As per claim 17, Luchs et al. teach the system of claim 13 as described above. Luchs et al. further teach the parameter change comprises a change in resident address of the policyholder (see figure 11A).

22. As per claim 18, Luchs et al. teach the system of claim 13 as described above. Luchs et al. further teach the parameter change comprises a change in garage location of a vehicle insured under the policy (see column 8, lines 16-18).

23. As per claim 19, Luchs et al. teach the system of claim 13 as described above. Luchs et al. further teach the parameter change comprises a change in item insured by the policy (see column 3, lines 25-29).

24. As per claim 20, Luchs et al. teach the system of claim 19 as described above. Luchs et al. further teach the change in item comprises a change in a person insured under the policy (see column 8, lines 16-18, particularly Addl. Names insured from the table referenced).

25. As per claim 21, Luchs et al. teach the system of claim 19 as described above. Luchs et al. further teach the change in item comprises a change in insurance coverages, deductibles and policy limits under the policy (see column 3, lines 25-29).

26. As per claim 22, Luchs et al. teach the system of claim 19 as described above. Luchs et al. further teach the change in item comprises a vehicle change (see column 25, lines 1-2).

27. As per claim 23, Luchs et al. teach the system of claim 22 as described above. Luchs et al. further teach the vehicle changes comprise adding, replacing, or deleting an insured vehicle under the policy (see column 25, lines 1-13).

28. As per claim 24, Luchs et al. teach the system of claim 13 as described above. Luchs et al. further teach an implementing module for submitting and implementing the parameter change (see column 25, lines 57-60).

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 25-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al., U.S. Patent No. 4,831,526 in view of Pasher.

31. As per claim 25, Luchs et al. teach a method of servicing an insurance policy via on-line communications for estimating cost variances attributable to policy parameter changes and for real-time updating of the policy parameters, comprising: communicating from a policyholder through an on-line connection an identity of the policyholder and a policy parameter change to an insurer (see column 3, lines 21-29); calculating a cost variance attributable to the policy parameter change and quoting the cost variance directly to the policyholder back through the on-line connection (see column 3, lines 37-38); submitting the policy parameter change as an implementable change for updating the policy (see column 25, lines 51-57); and adjusting the policy in accordance with the policy parameter change and verifying the adjusting in real-time directly back to the policyholder through the on-line connection (see column 25, lines 57-60). Luchs et al. do not explicitly teach using the on-line insurance policy service system over the Internet. Pasher discloses an on-line insurance policy service method for direct communication between an insurer and a policyholder used over the Internet (see paragraphs 11-14). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Luchs et al. to include access over the Internet for the purpose of allowing customers the ability to change their policies from any location in the world that they have access to the Internet.

32. As per claim 26, Luchs et al. in view of Pasher teach the method of claim 25 as described above. Luchs et al. further teach displaying policy information to the policyholder comprising preexisting policy parameters (see column 6, lines 42-44).

33. As per claim 27, Luchs et al. in view of Pasher teach the method of claim 25 as described above. Luchs et al. further teach providing on-line forms to the policyholder (see column 3, lines 21-25).

34. As per claim 28, Luchs et al. in view of Pasher teach the method of claim 25 as described above. Pasher further discloses enabling electronic funds transferring through the on-line connection for payment of policy premiums

35. As per claim 29, Luchs et al. in view of Pasher teach the method of claim 25 as described above. Luchs et al. further teach displaying claims information to the policyholder and enabling communication of related information concerning a claim through the on-line connection (see column 11, lines 60-65).

As per claim 30, Luchs et al. in view of Pasher teach the method of claim 25 as described above. Luchs et al. further teach communicating the policy parameter change comprises at least one of: a vehicle, deletion or replacement, a change in insureds listed in the policy, a change in address or telephone number for an insured, a change in a garage location of an insured vehicle or changes in policy limits, desired coverages or deductibles (see column 8, lines 16-18, particularly the charts cited).

36. As per claim 31, Luchs et al. teach a method of servicing a preexisting insurance policy via on-line communications for estimating cost variances attributable to policy parameter changes and for real-time updating of the policy parameters, comprising:

communicating by a policyholder and an insurer through an on-line connection an identity of the policyholder and a policy parameter change (see column 3, lines 21-29); determining a coverage variance attributable to the policy parameter change and quoting by the insurer the cost variance to the policyholder directly back through the on-line connection (see column 3, lines 37-38); submitting the policy parameter change as an implementable change for updating the policy (see column 25, lines 51-57); and adjusting the policy in accordance with the policy parameter change and verifying the adjusting in real-time back to the policyholder through the on-line connection (see column 25, lines 57-60). Luchs et al. do not explicitly teach using the on-line insurance policy service system over the Internet. Pasher discloses an on-line insurance policy service method for communication between an insurer and a policyholder used over the Internet (see paragraphs 11-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Luchs et al. to include access over the Internet for the purpose of allowing customers the ability to change their policies from any location in the world that they have access to the Internet.

37. As per claim 32, Luchs et al. in view of Pasher teach the method of claim 31 as described above. Luchs et al. further teach displaying policy information to the policyholder comprising preexisting policy parameters (see column 6, lines 42-44).

38. As per claim 33, Luchs et al. in view of Pasher teach the method of claim 31 as described above. Luchs et al. further teach providing on-line forms to the policyholder (see column 3, lines 21-25).

39. As per claim 34, Luchs et al. in view of Pasher teach the method of claim 31 as described above. Pasher further discloses enabling electronic funds transferring through the on-line connection for payment of policy premiums.

40. As per claim 35, Luchs et al. in view of Pasher teach the method of claim 31 as described above. Luchs et al. further teach displaying claims information to the

customer and enabling communication of related information concerning a claim through the on-line connection (see column 11, lines 60-65).

41. As per claim 36, Luchs et al. in view of Pasher teach the method of claim 31 as described above. Luchs et al. further teach communicating the policy parameter change comprises at least one of: a vehicle, deletion or replacement, a change in insured's listed in the policy, a change in address or telephone number for an insured, a change in a garage location of an insured vehicle or changes in policy limits, desired coverages or deductibles (see column 8, lines 16-18, particularly the charts cited).

42. As per claim 37, Luchs et al. teach a fully-automated on-line insurance policy service system operated by a policyholder and delivered via an electronic communications network, for real-time selective adjustment by the policyholder of policy parameters for a policy and system underwriting of risk and the resulting computation and communication of consequent costs, comprising: an information module for identifying a policyholder to the system and for verifying to the policyholder present policy parameters (see column 3, lines 44-49); a policy adjustment module for a policyholder directly communicating a parameter change and for generating in real-time a cost adjustment attributable to the parameter change and directly communicating to the policyholder the resulting cost adjustment (see column 24, lines 17-28, the change must communicated to the policyholder for him/her to approve it), which module includes the embedded capability to electronically perform underwriting and rating functions and apply relevance criteria based on prior policyholder responses to ensure accurate communication, policy adjustment and rating (see column 4, lines 35-47). Luchs et al. do not explicitly teach using the on-line insurance policy service system over the Internet. Pasher discloses an on-line insurance policy service method for communication between an insurer and a policyholder used over the Internet (see paragraphs 11-14). It would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the system of Luchs et al. to include access over the Internet for the purpose of allowing customers the ability to change their policies from any location in the world that they have access to the Internet.

43. Claims 38-48 contain similar limitations to claims 2-12 and, as such, are rejected for similar reasons.

44. As per claim 49, Luchs et al. teach a fully-automated on-line insurance policy service system operated by a policyholder and delivered via an electronic communications network, for real-time selective adjustment by the policyholder of policy parameters for a policy and system underwriting of risk and the resulting computation and communication of consequent costs, comprising: an information module for identifying a policyholder to the system and for verifying to the policyholder present policy parameters of a policy held by the policyholder (see column 3, lines 44-49); and a policy adjustment module for a policyholder directly communicating a parameter change to the insurer, for generating, electronically and in real-time, a coverage adjustment directly to the policyholder (see column 24, lines 17-28, the change must communicated to the policyholder for him/her to approve it), which module includes the embedded capability to electronically perform underwriting and rating functions and apply relevance criteria to ensure accurate communication, policy adjustment and rating (see column 4, lines 35-47). Luchs et al. do not explicitly teach using the on-line insurance policy service system over the Internet. Pasher discloses an on-line insurance policy service method for communication between an insurer and a policyholder used over the Internet (see paragraphs 11-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Luchs et al. to include access over the Internet for the purpose of allowing customers the ability to change their policies from any location in the world that they have access to the Internet.

45. Claims 50-60 contain similar limitations to claims 2-12 and, as such, are rejected for similar reasons.

46. As per claim 61, Luchs et al. teach a method of self-administering and modifying, amending and/or supplementing an insurance policy via on-line communications directly between a policyholder and an insurer allowing the policyholder to submit and effect policy parameter changes, determining cost variances attributable to policy parameter changes and for real-time updating of the policy parameters, comprising: communicating through an online connection the identity of the policyholder and a policy parameter change to an insurer (see column 3, lines 44-49); underwriting the risk resulting from the parameter change (see column 4, lines 35-42); calculating a cost variance attributable to the policy parameter change and quoting the cost variance directly to the policyholder back through the online connection (see column 24, lines 17-21); submitting the policy parameter change as an implementable change for updating the policy (see column 24, lines 21-24); and changing the policy in accordance with the policy parameter change and verifying the adjusting in real-time directly back to the policyholder through the on-line connection (see column 24, lines 24-28). Luchs et al. do not explicitly teach using the on-line insurance policy service system over the Internet. Pasher discloses an on-line insurance policy service method for communication between an insurer and a policyholder used over the Internet (see paragraphs 11-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Luchs et al. to include access over the Internet for the purpose of allowing customers the ability to change their policies from any location in the world that they have access to the Internet.

47. Claims 62-66 contain similar limitations to claims 26-30 and, as such, are rejected for similar reasons.

48. As per claim 67, Luchs et al. teach a method of self-servicing an existing insurance policy held by the policyholder, via an electronic communications network, directly between a policyholder and an insurer, for estimating cost variances attributable to policy parameter changes and for real-time updating of the policy parameters, comprising: communicating by a policyholder to an insurer, through an online connection, an identity of the policyholder and a policy parameter change (see column 3, lines 44-49); determining a coverage variance attributable to the policy parameter change and quoting by the insurer of the cost variance to the policyholder directly back through the on-line connection (see column 24, lines 17-21); submitting the policy parameter change as an implementable change for updating the policy (see column 24, lines 21-24); adjusting the policy in accordance with the policy parameter change and verifying the adjustment in real-time back to the policyholder through the on-line connection (see column 24, lines 24-28). Luchs et al. do not explicitly teach using the on-line insurance policy service system over the Internet. Pasher discloses an on-line insurance policy service method for communication between an insurer and a policyholder used over the Internet (see paragraphs 11-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Luchs et al. to include access over the Internet for the purpose of allowing customers the ability to change their policies from any location in the world that they have access to the Internet.

49. Claims 68-72 are similar to claims 26-30 and, as such, are rejected for similar reasons.

Response to Arguments

50. In the remarks filed 9/7/01 in paper number 6, Applicants argue in substance that Luchs et al. fail to teach a system that allows direct online communication between a policyholder and insurer without any involvement of an agent, operator or underwriter.

51. In response to Applicants argument, the limitation of an insurance system operable by a policyholder without and involvement of an agent, operator, underwriter, etc. is only mentioned in independent claim 61. This element is only mentioned in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, Luchs et al. teach all of the method steps as described above. Furthermore, Luchs et al. alone or in combination with Pasher teaches all of the elements of the remaining claims and thus the rejections are proper.

Conclusion

52. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

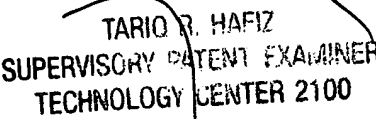
53. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

54. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on 8am-5:30pm.

55. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-5579 for regular communications and (703) 308-1396 for After Final communications.

56. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

CLG
November 16, 2001


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100